

REMARKS

By the present amendment, dependent claims 12 and 23 and 26 have been cancelled. Independent claims 1 and 13 have been amended to include limitations similar to those of claim 12 previously on file, and independent claim 14 has been amended to include limitations similar to those of claim 23 previously on file. Previously independent claim 24 has been re-written in dependent form. New claims 27-33 have been added, of which claim 27 presents limitations similar to those of claim 9 previously on file, and claim 28 presents limitations similar to those of claim 16 previously on file. Accordingly, claims 1-11, 13-22, 24-25 and 27-33 are presently pending, and favorable reconsideration thereof is respectfully requested. Claims 1, 13, 14, 27-29 and 31-32 are the independent claims.

Applicant wishes to thank the Examiner for the withdrawal of all previous grounds of rejection and objection.

Allowable subject-matter

Applicant also wishes to thank the Examiner for the indication that claims 9, 12, 16 and 23 previously on file would be allowable if re-written in independent form to include the limitations of the base claim and any intervening claims.

As discussed below, independent claim 1 as amended effectively re-writes claim 12 previously on file in independent form, and independent claim 13 has been amended to recite similar limitations. Independent claim 14 as amended effectively re-writes claim 23 previously on file in independent form. New claim 27 effectively re-writes claim 9 previously on file in independent form, and new claim 28 effectively re-writes claim 16 previously on file in independent form. Applicant therefore respectfully submits that independent claims 1, 13, 14, 27 and 28 are allowable for the same reasons that the Examiner viewed claims 9, 12, 16 and 23 as being allowable.

35 U.S.C. §102(b)

The Examiner has rejected claims 1-5, 11, 13-15, 17 and 24-26 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,026,460 to David et al. ("David").

Applicant respectfully notes that David issued on February 15, 2000, whereas the present application was filed on December 2, 1998. Thus, David is not citable against the present application under 35 U.S.C. §102(b), due to its issue date. Applicant assumes that the Examiner intended to cite David under 35 U.S.C. §102(e). Therefore, in order to avoid the necessity of a further Office Action citing David under §102(e), Applicant offers the following observations in relation to the David reference, in order to expedite the allowance of the present application.

By the present amendment, independent claim 1 has been amended to effectively include the limitations of claim 12 previously on file, which the Examiner has expressly indicated to be allowable if re-written in independent form. (Claim 12 previously on file depended directly upon claim 1, with no intervening claims.) Accordingly, Applicant respectfully submits that the rejection of claim 1 is overcome.

Claims 2-5 and 11 are directly or indirectly dependent upon amended claim 1. Applicant therefore respectfully submits that these claims are allowable due to their dependencies, as well as the additional subject-matter that each of these claims recites.

By the present amendment, independent claim 13 has also been amended to recite limitations similar to those of claim 12 previously on file, which the Examiner has expressly indicated to be allowable if re-written in independent form. Accordingly, Applicant respectfully submits that the rejection of claim 13 is overcome.

By the present amendment, independent claim 14 has been amended to effectively include the limitations of claim 23 previously on file, which the Examiner has expressly indicated to be allowable if re-written in independent form. (Claim 23 previously on file depended directly upon claim 14, with no intervening claims.) Accordingly, Applicant respectfully submits that the rejection of claim 14 is overcome.

Claims 15 and 17 are directly dependent upon amended claim 14. Similarly, by the present amendment, claim 24 has been re-written to be dependent upon claim 14, and therefore, claims 24 and 25 are also directly or indirectly dependent upon amended claim 14. Applicant therefore respectfully submits that these claims are allowable due to their dependencies, as well as the additional subject-matter that each of these claims recites.

Claim 26 has been cancelled, and therefore, the rejection of this claim is also overcome.

35 U.S.C. § 103(a)

The Examiner has rejected claims 6-8, 10 and 18-21 under 35 U.S.C. § 103(a) as being unpatentable over David in view of U.S. Patent No. 6,097,698 to Yang et al. Although the Examiner has not specifically commented upon claim 22, Applicant assumes from the Office Action Summary that the Examiner intended to include claim 22 under this heading.

Claims 6-8 and 10 are directly or indirectly dependent upon amended claim 1, and claims 18-22 are directly or indirectly dependent upon amended claim 14. As claims 1 and 14 have been shown to be allowable under the previous heading, Applicant respectfully submits that claims 6-8, 10 and 18-22 are allowable due to their dependencies, as well as the additional subject-matter that each of these claims recites.

New Claims 27-33

As noted above, new independent claim 27 effectively re-writes dependent claim 9 previously on file in independent form, including the limitations of the base claim and any intervening claims (in this case, claims 1, 2, 6 and 7 previously on file). Similarly, new independent claim 28 effectively re-writes dependent claim 16 previously on file in independent form, including the limitations of the base claim (14) and any intervening claims (none). As the Examiner has expressly indicated claims 9 and 16 to be allowable if re-written in this manner, Applicant respectfully submits that new claims 27 and 28 are allowable.

Independent claim 29 recites:

29. (New) A method of controlling the flow of data units across a bus bridge, the method comprising:
- a) detecting operational states of the bridge including a first operational state in which the bridge has insufficient storage capacity to store a complete data unit, and a second operational state in which the bridge has sufficient storage capacity to store a complete data unit;
 - b) disabling load access to the bridge when the first predefined operational state exists at the bridge; and
 - c) enabling load access to the bridge when the second predefined operational state exists at the bridge.

Thus, new claim 29 recites that the step of "detecting operational states of the bridge" includes detecting "a first operational state in which the bridge has insufficient storage capacity to store a complete data unit, and a second operational state in which the bridge has sufficient storage capacity to store a complete data unit". Support for these latter limitations may be found

throughout applicant's specification, such as at page 11, lines 5-14, for example.

Applicant respectfully submits that the cited references fail to satisfy the requirements for a finding of either anticipation or *prima facie* obviousness of claim 29. In this regard, the primary reference cited in the present Office Action, namely, the David reference (U.S. 6,026,460), appears to be concerned only with whether the inbound posting buffer is or is not empty (see e.g. col. 3 lines 12-20). David fails to disclose or suggest any consideration of whether the inbound posting buffer has "sufficient storage capacity to store a complete data unit" as recited in claim 29. Thus, David fails to disclose or suggest "detecting ... a first operational state in which the bridge has insufficient storage capacity to store a complete data unit, and a second operational state in which the bridge has sufficient storage capacity to store a complete data unit", as recited in claim 29. Moreover, even if the Examiner were to compare the "empty" state of the inbound posting buffer in David to the "second operational state in which the bridge has sufficient storage capacity to store a complete data unit" recited in claim 29, David discloses that "The control logic disables the inbound posting buffer as soon as the inbound posting buffer is empty." (see e.g. col. 3 lines 14-15). Thus, even if the Examiner were to draw the above comparison, David expressly teaches away from "enabling load access to the bridge when the second predefined operational state exists at the bridge", as recited in claim 29. Accordingly, in view of these differences, Applicant respectfully submits that David can neither anticipate nor support a *prima facie* case of obviousness of new claim 29, and therefore respectfully submits that new claim 29 is allowable.

New independent claims 31 and 32 recite limitations similar to those discussed above in connection with claim 29. Applicant therefore respectfully submits that these claims are allowable for reasons similar to those presented above in connection with claim 29.

New claims 30 and 33 are dependent upon claims 29 and 32, respectively. Applicant therefore respectfully submits that these claims are allowable due to their dependencies, as well as the additional subject-matter that each of these claims recites.

Excess Claim Fees

By the present amendment, three claims (12, 23 and 26) have been cancelled, and seven claims (27-33) have been added. Thus, the total number of pending claims has increased by four beyond the highest number previously paid for, to a total of 30 pending claims.

In addition, independent claim 24 has been re-written as a dependent claim, and five independent claims (27-29 and 31-32) have been added. Thus, the number of pending independent claims has increased by four beyond the highest number previously paid for, to a total of eight independent claims.


Applicant encloses a bank draft in the amount of \$416 as payment for the required excess claim fees. The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to our deposit account no. **06-0713**.

Conclusion

In view of the foregoing, Applicant respectfully submits that the present application is in condition for allowance, and respectfully requests that a Notice of Allowance be issued. Applicant respectfully notes that the present application has now been pending for more than five and a half years, partly due to an internal error in the USPTO resulting in the misplacement or loss of applicant's response to a previous office action, resulting in a Notice of Abandonment, and necessitating a Petition to Withdraw the Holding of Abandonment, and partly due to the issuance of four separate non-final Office Actions on the merits. However, the present application is not eligible for a patent term extension, due to its filing date. Accordingly, should the Examiner have any outstanding concerns, the Examiner is respectfully requested to

contact the undersigned agent by telephone at the Examiner's earliest convenience, to expedite the prosecution and allowance of this application.

Respectfully submitted,



Stephen J. Ferance, Reg. No. 48,090
SMART & BIGGAR
Box 11560 Vancouver Centre
2200 – 650 West Georgia Street
Vancouver, British Columbia
Canada V6B 4N8
Telephone: 604-682-7780
Facsimile: 604-682-0274

SJF:cat

Encl.: Bank draft for \$416 for excess claim fees.